

### **DETAILED ACTION**

1. Applicant's amendment filed 1/18/2012 is entered. Claims 165, 218, 252 and 260 are currently amended. Claims 165-185, 218-236, 247, 250, 252-261 are pending. Claims 168-184, 221-235, 247 and 250 are previously withdrawn. Claims 165-167, 185, 218-220, 236, 252 and 256-261 will be further examined on merits.

2. Telephone Interview: A telephone interview was conducted between the Examiner and Applicant's representative Ms. Elena Dreszer on February 22/23, 2012. For details, please refer to the Interview summary enclosed.

3. In view of the current amendments previous Objection to Specification for introducing new matter and rejections under 35 USC 112, first and second paragraphs are now moot and withdrawn. However, new amendments present new problems such as (a) new amendments are not in line with the most recent Declaration filed 6/7/2010 and therefore would be subject to rejection under 35 USC 251 due to defective oath/declaration, (b) raises new indefiniteness issues and hence would be subject to rejection under 35 USC 112, second paragraph rejection.

4 The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

The substitute declaration filed 6/7/2010 included following error statement:

"the specification of which was filed on July 10, 2001 as application serial no. 09/903,457. I believe original patent 5,819,034 ('~the '034 patent'), to be

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wholly or partly inoperative by reason of my claiming less than I had the right to claim in the patent. The claims of the '034 patent relate to a distributed computer system. For example, claim 1 recites a distributed computer system reciting, inter alia, a "further processor including means to ... form an interactive video program in which execution of said distributed computing application alters said video program." However, the '034 patent also discloses a method and system that, stated generally, uses a client system to facilitate the determining of an item identity for an item to which an order request pertains, automatically retrieving personal information previously stored in a permanent memory in the client system, and causing an order to be placed, where the order including the item identity and the retrieved personal information. This invention is distinct from the invention claimed in the original patent; and is not in any way claimed in the issued claims of the '034 patent. The above quoted language of issued claim 1 is not necessary for patentability of claims drawn to the identified disclosed but unclaimed invention, and thus the presence of this limitation renders the '034 patent partly inoperative. This error is addressed in this reissue by eliminating limitations found in the issued claims, including the limitation from issued claim 1 of the '034 patent quoted above, and by including claims directed to methods of, and systems for, facilitating ordering an item, where the order includes the item identity and the retrieved previously stored personal information. In particular, the error is addressed by the presentation of claims 165-167, 185, 218-220, 236, 252, and 256-261, drawn to this previously unclaimed invention."

The current amendments, filed 1/18/2012, made to independent claims 165, 218, 252 and 260 do not include the above cited [specially the language marked in italics above] language describing the error and therefore renders the declaration filed 6/7/2010 defective.

5 Claims 165-167, 185, 218-220, 236, 252 and 256-261 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251 as set forth above.

See 37 CFR 1.175.

The nature of the defect(s) in the Declaration is set forth in the discussion above in this Office action.

6. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 165-167, 185, 218-220, 236, 252 and 256-261 are rejected as being based upon a defective reissue Declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

See MPEP § 1414.01.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 165-167, 185, 218-220, 236, 252 and 256-261 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements/method steps, such omission amounting to a gap between the elements. See

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MPEP § 2172.01. The claimed invention refers to receiving order requests from a user and automatically determining the identity for an item to which the order request pertains and this invention is implemented as per the embodiment disclosed in col.8, line 22- col.9, line 6. With reference to independent claims 165, 218, 252 and 260, the omitted elements/method steps are marked in underlined/italics (see col.8, line 22-col.9, line 6), for example for claim 165, as given below:

Claim 165. A method to facilitate placing an order for an item, the method comprising:

at a source of a data stream, providing a series of time division multiplexed packets, ones of which contain auxiliary data that represent a video program, and others of which represent a distributed computing application associated with said video program, and wherein said distributed computing application is repetitively transmitted independent of receiving client computer apparatus during times that said video program is transmitted;

~~receiving an order request at a client system, the~~ A client system comprising a packet selector connected to said source for selecting and directing packets containing said auxiliary data representing said video program to a video signal processor and selecting and directing packets containing said associated distributed computing application to a further processor, said further processor including means to assemble said distributed computing application and execute said distributed computing application to form an interactive video program with an executable code in which execution of said distributed computing application alters said video program;

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the executable code causing, at a client system, display of interactive information associated with the video program while the video program is being showed at the client system ;

the interactive information associated with the television program describing an item to said video program viewer;

receiving an order request at the client system, from the video viewer via the interactive information displayed at the client system;

automatically determining an item identity for an item to which the order request pertains; and

causing an order to be placed, the order including the item identity.

The other independent claims 218, 252 and 260 lack similar essential elements and are rejected for the same reasons. Dependent claims 166-167, 185, 219-220, 236, and 256-259, 261 do not overcome these efficiencies and are therefore rejected on the basis of same rationale as set forth for claims 165, 218, 252 and 260.

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims

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are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 165, 218, 252 and 260 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over (a) claims 10, 38, 260 of copending Application No. 09/672523 and (b) claims 68, 87, 101, 106, and 125 of copending Application No. 09/903448 . Although the conflicting claims are not identical, they are not patentably distinct from each other because they all are

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directed to same inventive concept that is a system/method facilitating ordering an item using a distributed computing system including at least one client system and at least one server, whereby the client system receives a video data stream from the server, item data, the item data including interactive information application to show and describe the item via the client system and an item identifier to identify the item as currently being offered for sale, based on the video data stream being viewed the client system receiving an order request from the user and causing an order to be placed for the item.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Information Disclosure Statement***

9. The information disclosure statement filed 1/18/2012 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. Many of the listed references are foreign patent documents without corresponding English translation and therefore those references have been lined and not considered.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOGESH C. GARG whose telephone number is (571)272-6756. The examiner can normally be reached on Increased Flex/Hoteling.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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